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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,319	12/08/2003	Adi Shefer	4686-125 US	5051
<div><div>759002/11/2008</div><div>Diane Dunn McKay, Esq. Mathews, Collins, Shepherd &amp; McKay, P.A. Suite 306 100 Thanet Circle Princeton, NJ 08540</div></div>				
			EXAMINER	
			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	
			MAIL DATE	DELIVERY MODE
			02/11/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/731,319

Applicant(s)

SHEFER ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters; prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/4/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on October 18, 2007. Claims 1-3, 5-23, 25 are pending. Claim rejections made under 35 U.S.C. § 112, second par., as indicated in the previous Office action, are withdrawn in view of the claim amendment made by applicants. Claim rejection made under §102(b) in view of Maruyama (US 4269729) is modified to address the claim amendment, but otherwise maintained. Claim rejections made under § 102(b) in view of Trinh et al. (US 6001789), and the 103(a) rejection made under Smithies (US 4183911) in view of Ferentchak (US 4818522) are withdrawn in view of the claim amendment. New rejections are made to address the amended claims.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 2, 5-8, 10, 14-17, 22, 23, and 25 are rejected under 35 U.S.C. U.S.C. 102(b) as being anticipated by Maruyama et al. (US 4269729) and further evidenced by US 6001789.**

Maruyama discloses microcapsules comprising linalool (Clog P of less than 3) encapsulated with water-soluble (moisture sensitive) polyvinyl alcohol and the method of making thereof. See Example 4; instant claims 1, 2, 4, 5, and 25. The capsules are solid states, as the reference indicates that the capsules are dried and then particles in powder form. The capsules have size of 100 microns. See instant claim 8. Since the

composition is in the form of powder, it meets the anhydrous limitation of instant claim 10, 14, and 22. The fragrance is dissolved in paraffin in the process of making the composition, and paraffin meets the moisturizer limitation of instant claim 16. The "deodorant body powder" of instant claim 17 is directed to the intended use of the prior art powder product, so no patentable weight is given. See MPEP § 2111.02. In claim 1, the fragrance releasing properties of instant claims 1, 15, and 23 are viewed inherent to the prior art composition which meets the limitations of the present claims. US 6001789 teaches that linalool has Clog P value of 2.55 and boiling point of 193 °C. See col. 9, line 25. For claims 11-13,

**Claims 1-3, 8, 9, 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Trinh et al. (US 6001789).**

Trinh discloses block detergent composition which comprises water-activated matrix perfume microcapsules. See Examples I -III; instant claims 18, 20, 22, 24. The perfumes used in the examples are illustrated in col. 18, line 30 - col. 21, line 37, and their properties are disclosed in Tables 1-3 of col. 7, line 37 - col. 3, line 61. See instant claims 1-3. The size of the microcapsules is disclosed in col. 13, lines 30-33. See instant claims 8 and 9. The fragrance burst property as described in instant claims 1, 19, and 23 are inherent to the prior art composition that meets the limitations of the instant claims. The products of instant claim 21 are directed to the intended use of the stick composition of instant claim 18, and no patentable weights are given to these terms. MPEP § 2111.02.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 3, 18-21 are rejected under 35 U.S.C. 102(b) as being unpatentable over Maruyama et al. (US 4269729) as applied to claims 1, 2, 5-8, 10, 14-17, 22, 23, and 25 as above, and further in view of Finucane et al. (US 6248703 B1).**

Maruyama does not specifically teach the claimed application of the microspheres in making a soap bar.

Finuncane teaches that it is well known practice in cosmetic art to make soap bar comprising encapsulated benefit agent such as essential oils (linalool). See col. 8, line 18. The reference also teaches that the soap composition also comprises perfumes as an adjuvant, other than the benefit agent. See Example 2 and Claim 1 (d); instant claim 3.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Maruyama by making a soap bar containing the solid polyvinyl alcohol microspheres comprising encapsulated linalool, as motivated by Finucane. The skilled artisan would have had a reasonable expectation of successfully producing a similar soap bar which releases the perfume upon use.

**Claims 9, 11-13 are rejected under 35 U.S.C. U.S.C. 102(b) as being unpatentable over Maruyama et al. (US 4269729) as applied to claims 1, 2, 5-8, 10, 14-17, 22, 23, and 25 as above, and further in view of Smithies (US 4183911) and Ferentchak (US 4818522).**

Maruyama does not specifically indicate the application of the microcapsules in spray products.

Smithies discloses an antiperspirant spray comprising perfume and encapsulated antiperspirant actives.

While Smithies does not specifically indicate to encapsulate perfume, Ferentchak teaches antiperspirant formulations comprising encapsulated water immiscible perfume or antibacterial with outer materials that slowly dissolves with perspiration. See Examples I-III; instant claims 1, 10, 14, 16. The size of the particles is taught in col. 5, lines 28-37; instant claim 8.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Maruyama by making a antiperspirant spray containing the solid polyvinyl alcohol microspheres comprising encapsulated perfume, as motivated by Smithies and Ferentchak, because 1) Smithies teaches spray products comprising encapsulated active ingredients, and 2) Ferentchak teaches that the slow release of adjuvant is advantageous. The skilled artisan would have had a reasonable expectation of successfully producing an antiperspirant spray with a controlled release of perfume.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-3, 5-23, 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 7115282 B2.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of the claims are directed to controlled release composition comprising a plurality of moisture sensitive micro-spheres of overlapping limitations. The fragrances of the '282 claims are defined in the specification col. 7, lines 39-67, which meet the instant claim limitations which encompasses those perfumes having Clog P values of less than or equal to, and greater than equal to, 4.

### ***Response to Arguments***

Applicant's arguments filed on October 16, 2007 have been fully considered but they are not persuasive in part and moot in view of new grounds of rejection in part.

Applicants argue that the Maruyama's microcapsules are different from the present invention in that the prior art microspheres are not solid but include a hollow center surrounded by a wall of predetermined strength. The argument is not commensurate with the scope of the claim because whether the claimed invention excludes hollow microspheres is not recited in the body of the claims. Furthermore, applicant's distinction between "solid" and "hollow" is somewhat confusing. The claimed microspheres also 'encapsulate' the claimed fragrance, thus the microspheres of the present invention must have a hollow center which contains the active ingredient therein. Applicants' assertion that the prior art does not teach moisture-sensitive property of the microcapsules is also unpersuasive, because the prior art is made of polyvinyl alcohol, which applicants also used in the present invention. Applicants' argument that the reference fails to teach of the fragrance of the present invention is also unpersuasive, because, as indicated in the body of the rejection, Example 4 specifically illustrates microspheres comprising linalool, which is within the scope of the present invention. In response to applicants' assertion that the prior art fails to teach using menthol, menthol is not specifically claimed in the present application.

Applicants' arguments regarding the teachings of Smithies and Ferentchak are moot, as the rejection has been withdrawn in view of the claim amendment. However, it is noted that the argument is also unpersuasive even in view of the new grounds of rejection made above. In response to applicant's arguments against the references



individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, neither of Smithies and Ferentchak teaches the present invention in a single reference. However, the references are cited in the rejection to show the teachings on the specific application of encapsulated perfumes in general that would have motivated a skilled artisan to modify the Maruyama invention to make the present invention.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Application/Control Number:  
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Art Unit: 1617

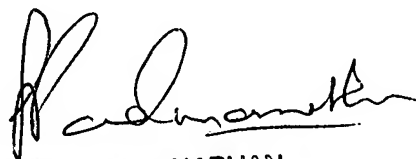
Page 9.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gina C. Yu  
Patent Examiner



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER